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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,967	08/23/2001	Tim Goldstein	10007814-1	1561

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

CHANDLER, SARA M

ART UNIT	PAPER NUMBER
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3693

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/27/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/935,967	Applicant(s) GOLDSTEIN ET AL.	
	Examiner Sara Chandler	Art Unit 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This Office Action is responsive to Applicant's arguments and request for reconsideration of application 09/935,967 (08/23/01) filed on 11/20/06.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15, 17 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 15, 17 and 27 are rejected because a product does not transmit messages.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 14-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin, US Pat. No. 5,883,810 in view of Bogat, US Pub. No. 2003/0022655.

Re Claims 14-22: Franklin discloses a system for enabling authorization of billing transactions, comprising:

a first computing unit interfaced with a network and configured to receive a first message comprising a unique identifier (Franklin, abstract, Figs. 1-5; col. 1, line 1+ - col. 2, line 67; col. 3, lines 5-55; col. 4, line 48+- col. 5, line 22; col. 6, lines 1-32; col. 7, lines 39-53; col. 8, lines 57- col. 9, lines 42).,

the first computing unit configured to store an account identifier that identifies a billing account for a user and to store, prior to receiving the first message, data that correlates the unique identifier with the account identifier (Franklin, abstract, Figs. 1-5; col. 1, line 1+ - col. 2, line 67; col. 3, lines 5-55; col. 4, line 48+- col. 5, line 22; col. 6, lines 1-32; col. 7, lines 39-53; col. 8, lines 57- col. 9, lines 42).,

the first computing unit configured to retrieve, in response to the first message, the account identifier based on the data and the unique identifier of the first message (Franklin, abstract, Figs. 1-5; col. 1, line 1+ - col. 2, line 67; col. 3, lines 5-55; col. 4, line 48+- col. 5, line 22; col. 6, lines 1-32; col. 7, lines 39-53; col. 8, lines 57- col. 9, lines 42) and to transmit, in response to the first message, the retrieved account identifier via the network to a second computing unit thereby enabling the second computing unit to bill a commercial transaction to the billing account (Franklin, abstract, Figs. 1-5; col. 1, line 1+

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- col. 2, line 67; col. 3, lines 5-55; col. 4, line 48+- col. 5, line 22; col. 6, lines 1-32; col. 7, lines 39-53; col. 8, lines 57- col. 9, lines 42).

Franklin fails to explicitly disclose wherein the unique identifier is a product identifier.

Bogat discloses wherein the unique identifier is a product identifier (Bogat, abstract; [0001] – [0012] ; [0021] – [0026] ; [0028] – [0032]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Franklin by adopting the teachings of Bogat to provide a system further comprising wherein the wherein the unique identifier is a product identifier.

As suggested by Bogat, one would have been motivated to avoid problems associated with loss of infrequently used cards or unauthorized use.

Re Claims 23-31: A method for enabling authorization of billing transactions, comprising:

receiving a unique identifier (Franklin, abstract, Figs. 1-5; col. 1, line 1+ - col. 2, line 67; col. 3, lines 5-55; col. 4, line 48+- col. 5, line 22; col. 6, lines 1-32; col. 7, lines 39-53; col. 8, lines 57- col. 9, lines 42);

storing, prior to the receiving, an account identifier and data, the account identifier identifying a billing account of a user, the and correlating the unique identifier with the account identifier (Franklin, abstract, Figs. 1-5; col. 1, line 1+ - col. 2, line 67; col. 3, lines 5-55; col. 4, line 48+- col. 5, line 22; col. 6, lines 1-32; col. 7, lines 39-53; col. 8, lines 57- col. 9, lines 42);

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retrieving, in response to the receiving, the account identifier based on the data and the received unique identifier (Franklin, abstract, Figs. 1-5; col. 1, line 1+ - col. 2, line 67; col. 3, lines 5-55; col. 4, line 48+- col. 5, line 22; col. 6, lines 1-32; col. 7, lines 39-53; col. 8, lines 57- col. 9, lines 42); and transmitting the retrieved account identifier via a network thereby enabling a commercial transaction to be billed to the billing account (Franklin, abstract, Figs. 1-5; col. 1, line 1+ - col. 2, line 67; col. 3, lines 5-55; col. 4, line 48+- col. 5, line 22; col. 6, lines 1-32; col. 7, lines 39-53; col. 8, lines 57- col. 9, lines 42).

Franklin fails to explicitly disclose wherein the unique identifier is a product identifier.

Bogat discloses wherein the unique identifier is a product identifier (Bogat, abstract; [0001] – [0012] ; [0021] – [0026] ; [0028] – [0032]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Franklin by adopting the teachings of Bogat to provide a method further comprising wherein the wherein the unique identifier is a product identifier.

As suggested by Bogat, one would have been motivated to avoid problems associated with loss of infrequently used cards or unauthorized use.

Response to Arguments

Applicant's arguments with respect to claims 14-31 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Hui, US Pub. No. 2002/0073027 – use of product, product identifier.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

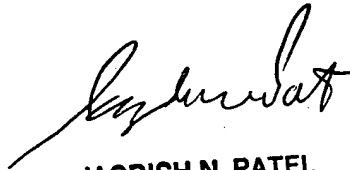
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Chandler whose telephone number is 571-272-1186. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SMC



JAGDISH N. PATEL
PRIMARY EXAMINER